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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,838	08/30/2000	Christer Fahraeus	62994	4391

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EXAMINER

NGUYEN, CHANH DUY

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,838

Applicant(s)

FAHRAEUS ET AL

Examiner

Chanh Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20,22-24,27-39,41 and 43-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20,22-24,27-39,41 and 43-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 03 February 2003 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Response to Amendment

1. The amendment filed on February 2003 has been entered and considered by examiner.

Specification

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Objections

3. Claims 1-19 are objected to because of the following informalities: the word "having" recited in the preamble of claim 1 should be deleted because "having" is not an element of the product recited in the claim 1. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-20, 22-24, 27-39, 41, 43-54 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Fahraeus (US 2001/0024193 A1).

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Fahraeus discloses the prior art most closely resembling the subject matter of the claims including position code, activation icon (see page 7, paragraph 0112).

The English translation of U.S. Provisional application Nos 60/152, 642 filed on September 7, 1999 has not received. Only two copies of the English language translation of U.S. Provisional Application Nos 60/208,168 and 60/210,564 have been received on October 01, 2001. Thus, the reference of Fahraeus having an effective filing date of January 21, 2000 is proper under 102 (e) until the English translation copy is provided. At that point, examiner can determine which claims recited in this instant application are not covered on U.S. Provisional application Nos. 60/152, 642.

6. Claim 46 is rejected under 35 U.S.C. 102(b) as being anticipated by Kahn et al (U.S. Patent No. 5,793,361).

As to claim 46, Kahn discloses a handheld wand (20) which adapted to carry out predetermined operations at the command of a user including a sensor (56) for detecting position on a writing surface (18). The term "writing surface" is so broad that it can read on any surface which can be written such as surface of a table or surface of building wall or surface of the CRT in this case.

Kahn teaches a signal processor (58) which is adapted to carry out in response to the sensor's detection of the activation icon (i.e., graphical user interface or GUI), one of the predetermined operation (see column 5, lines 18-25, column 7, lines 1-20, column 10, lines 27-36).

While Kahn's device differs from the disclosed' s device, it reads on broad claimed language. The claim is so broad that it reads on the use sensor (56) in pointer

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(20) of Kahn to detect the position of a graphical user interface, then a user can activate the detected position of the graphical user interface by using command button (51, 53, 55) on the pointer.

7. Claim 1-3, 9-14, 20, 22-24, 28-30, 32, 38, 41, 43-45 is rejected under 35 U.S.C. 102(e) as being anticipated by Hecht et al (U.S. Patent No. 6,327,395).

As to claim 43, Hecht discloses a system for information management including a sensing wand (1710) adapted to record information electronically from position information (see column 11, lines 49-56), a sensed product (any media including hard copy such as paper, label etc.) supplying the position information to the sensing wand (1710) and being provided at with at least one activation icon (e.g., icon David's DOC2) indicating a predetermined operation (see column 10, line 66 through column 11, line 7 and column 11, line 57 through column 12, line 41. Hecht clearly teaches the sensing wand (1710) being adapted to initiate the predetermined operation for the record information in response to the detection of at least one activation icon on the product (see column 12, lines 14-41).

As to claim 44, the term "writing surface" recited in the claim is so broad that it reads on the surface of Hecht. For example, Hecht teaches that "glyphs 22, and 23 that are written on a generally regular rectangular lattice of centers on a suitable recording medium 24"; see column 5, lines 26-28 and column 10, line 66 through column 11, line 8. Hecht clearly teaches position code (e.g., glyphs) coding a plurality of positions on the writing surface.

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As to claim 45, this claim differs from claim 43 in that the limitation "writing information on a replaceable surface using a writing wand sensing position directly from the writing surface" is substituted the limitation "a sensed product" as recited in claim 43. Hecht teaches "glyphs" can be written on paper (see column 10, line 66 through column 11, line 7. It is clear that paper is a replaceable writing surface.

As to claim 1, this claim differs from claim 43 only in that claim 43 is method claim whereas claim 1 is apparatus. Thus, apparatus claim 1 is analyzed as previously discussed with respect to method claim above.

As to claim 20, this claim differs from claim 1 in that the limitations "pen" and "a reader mounted for movement with the pen for reading said position code provided on the writing surface" are additionally recited. Hecht clearly teaches camera pen (1710) having camera (2716 or reader) for capture (or reading) a glyph address carpet (or position code).

As to claim 2, Hecht clearly teaches at least one activation icon provided with the position code (glyph); see column 11, lines 24-27.

As to claim 3, this claim is met by Hecht. For example, Figure 18 shows the position code (glyph) extending continuously over the writing surface.

As to claim 9, Hecht clearly teaches a plurality of activation icons (e.g., John'sdoc2, David'sdoc1).

As to claims 10-11, Hecht teaches camera (2716) being optical detector for detecting the activation icon (e.g., John'sdoc2) and the position code (glyph)

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As to claim 12, this claim is met by Hecht. For example, icon John'sdoc2 stores the recorded information at a predetermined location.

As to claim 13, Hecht clearly teaches the position code including a plurality of symbols (forward slash and backward slash) each symbol (e.g., forward slash) contributing to the coding of more than one position.

As to claim 14, Hecht teaches position code including a raster and a plurality of symbols as recited in the claim.

As to claims 15-19, since Hecht teaches that the position code (glyphs) can be formed on the paper. Thus, it is inherent that number of identical papers can be formed a note pad.

As to dependent claims 22-24, 28-30, 32 and 38,41, these claims are analyzed as previously discussed with respect to claims 1-3, 9-14, and met by Hecht.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 4-8, 15-19, 27, 31, 33-37, 39 and 47-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hecht et al in view of Lazzouni et al (U.S. Patent No. 5,661,506).

As to claim 47, note the discussion of Hecht above, Hecht discloses a method for interacting with information written on a writing surface provided a position code as recited in claim 47 with exception of describing the use of "handwritten information". In the same field of endeavor, Lazzouni teaches the step of processing position code to record handwritten information introduced to the writing surface by interaction with the pen (see column 8, lines 35-58. Therefore, it would have been obvious to one of ordinary skill in the art at the invention was made to have added the step of recording handwritten information on the paper as taught by Lazzouni to the step of identifying the position code to initiate the a predetermined operation of the activation icon of Hecht so that a user can perform two functions: writing and operation of icon on the same one device.

As to claim 51, this claim differs from claim 47 on the in that claim 47 is method whereas claim 51 is apparatus. Thus, apparatus claim 51 is analyzed as previsouly discussed with respect to method claim 47 above.

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As to claim 39, this claim is obvious over combination of Hecht and Lazzouni as pointed in the claim 47 above.

As to dependent claims 4-8, 15-19, 27, 31-37, 48-50 and 52-52, these claims are met by either Hecht or Lazzouni . For example, Hecht clearly teaches at least one activation icon as recited in claim 5. Lazzouni teaches a second set including character recognition area as recited in the claim 6-7.

Response to Arguments

11. Applicant's arguments with respect to claims 1-20, 22-24, 27-39, 41, 43-54 have been considered but are moot in view of the new ground(s) of rejection.

In view of amendment, the reference of Kahn, Hecht and Lazzouni have been added for new ground of rejection.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chanh Nguyen whose telephone number is (703) 308-6603.

If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, Steven Saras can be reached at 305-9720.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231


or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA, Sixth Floor (Receptionist)

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


C. Nguyen
April 17, 2002


CHANH NGUYEN
PRIMARY EXAMINER